

### **REMARKS**

Claims 1-30 were pending. Claims 13-22 and 24 have been withdrawn from consideration. Claims 1-12, 23, and 25-30 stand rejected. Claims 31-32 have been added. Claims 1 and 23 are currently amended. Claims 1-32 are presently pending.

Applicant has added new claims 31-32 to more clearly claim embodiments of Applicant's invention in which the carrier is permanently affixed to the bottom substrate surface, preferably using an adhesive or mechanical fastener. Applicant has amended independent claims 1 and 23 to clarify that in these claimed embodiments, the carrier is non-magnetically affixed to the bottom substrate surface. The new claims have been added and the amendments to claims 1 and 23 have been made for purposes of clarification and without adding new matter.

Support for the new claims and the amendments may be found, for example, in Applicant's specification at page 4, lines 29-31, and page 8, lines 27-31. Applicant notes, in particular, that Applicant's specification describes, at page 4, lines 29-31 that "the substrate and carrier can be connected with any suitable fastening technique including adhesive or mechanical fasteners." Applicant further notes that Applicant's repeated references, throughout Applicant's specification (see e.g. page 8, lines 25-27), that "the carrier 14 provides rigid support for the substrate 12" provides support for the limitation that the carrier is permanently affixed to the bottom substrate surface to provide rigid support.<sup>1</sup>

Applicant believes that the amendments place the application in condition for allowance. Applicant respectfully requests continued examination and reconsideration of the application as presently amended in view of the amendments, the arguments presented in Applicant's Appeal Brief submitted on June 7, 2007, which is incorporated herein in its entirety, and the following arguments.

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<sup>1</sup> See *In re Wright*, 866 F.2d 422, 9 USPQ2d, 1649 (Fed. Cir. 1989). In *In re Wright*, the addition by amendment of a claim limitation specifying that a powder "be distributed upon said support but *not permanently fixed thereto* (emphasis added) did not violate the written description requirement of 35 U.S.C. § 112, first paragraph, even though the specification as filed did not include the exact phrase "not permanently fixed," because the specification's examples warned that the powder not be distributed so as to change position in a subsequent image-forming step).

**Rejections under 35 U.S.C. § 102**

Claims 1 and 2 stand rejected under 35 USC § 102(e) as being purportedly anticipated by Gurusamy et al. (US 6,361,423). Applicant respectfully contends that the Office has only established that Gurusamy et al. discloses a chemical mechanical polishing conditioner in which the alleged carrier 158 is magnetically and thus non-permanently affixed to the alleged substrate. The Office admits, in the Examiner's Reply Brief, that the Gurusamy et al. carrier 158 is removably affixed by magnetic force.<sup>2</sup> Applicant respectfully contends that Applicant's claims are not anticipated by Gurusamy et al., at least because independent claims 1 and 23, as presently amended, include a limitation that the carrier is non-magnetically affixed to the bottom substrate surface, and further, because new independent claim 31 includes a limitation that the carrier is permanently affixed to the bottom substrate surface. Applicant thus respectfully submits that the office has not established that Gurusamy et al. discloses all-elements of Applicant's claimed invention, as required to support a rejection for alleged anticipation.<sup>3</sup> In addition to the foregoing, Applicant respectfully submits that a dependent claim should be allowed when its parent claim is allowed.<sup>4</sup> The rejection of claims 1 and 2 under 35 USC § 102(e) as being allegedly anticipated by Gurusamy et al. has been overcome and should be withdrawn.

**Rejections under 35 U.S.C. § 103**

Claims 1-12, 23 and 25-30 stand rejected under 35 USC § 103(a) as being unpatentable over Sung (US 6,679,243) in view of Gurusamy et al. (US 6,361,423). In view of the foregoing argument with respect to the failure of Gurusamy et al. to disclose all elements of Applicant's claimed invention, and further, in view of the absence in the record of evidence that Sung discloses, teaches or suggests a chemical mechanical polishing conditioner in which a carrier is non-magnetically and/or permanently affixed to a bottom substrate surface, Applicant respectfully contends that the Office has not established a proper *prima facie* case of obviousness over the cited references.

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<sup>2</sup> Examiner's Reply Brief submitted September 27, 2007, page 8, referencing U.S. 6,361,423 B2, col. 11, lines 34-45.

<sup>3</sup> See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81 (Fed. Cir. 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

<sup>4</sup> *In re McCarn*, 101 USPQ 411 (CCPA 1954).

Applicant respectfully contends that a proper case of *prima facie* obviousness has not been established at least because independent claims 1 and 23, as presently amended, include a limitation that the carrier is non-magnetically affixed to the bottom substrate surface, and further, because new independent claim 31 includes a limitation that the carrier is permanently affixed to the bottom substrate surface. Applicant respectfully submits that the Office has not met its burden of establishing that the combination of references discloses, teaches, or suggests all elements of Applicant's claimed invention. The rejection of claims 1-12, 23 and 25-30 under 35 USC § 103(a) as being allegedly unpatentable over Sung in view of Gurusamy et al. has been overcome and should be withdrawn.

### CONCLUSION

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is respectfully requested. Prompt allowance of all pending claims as presently amended is solicited. If the Office disagrees, Applicant respectfully requests a telephone interview to more fully understand the Examiner's position and advance this case to issuance.

Respectfully submitted,

10/29/07  
Date

By: James A. Baker  
James A. Baker, Reg. No.: 44,520  
Telephone No.: 651-736-9667

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833

JAB/spg